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Total Number of Pages in This Submission

TECH CENTER 6042900

Application Number	Patent#: 6,794,169
Filing Date	Issued: September 21, 2004
First Named Inventor	Tilo Schwientek
Art Unit	1653
Examiner Name	M. Monshipouri
Attorney Docket Number	04305/100G031-US2

## ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Submission Under C.F.R. Section 1.501 (2 pages); U.S. Patent 6,593,119; Certificate of Express Mailing (1 page); Return Receipt Postcard
<div>Remarks</div>		

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	DARBY & DARBY P.C.		
Signature			
Printed name	Heather Morehouse Ettinger		
Date	December 1, 2006	Reg. No.	51,658

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Docket No.: 04305/100G031-US2  
(PATENT)

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Letters Patent of:  
Tilo Schwientek et al.

Patent No.: 6,794,169

Issued: September 21, 2004

For: UDP-N-Acetylglucosamine: Galactose-B1,3-N-  
Acetylgalactosamine-a-R/ (GlcNAc to GalNAc)  
B1-6 N-Acetylglucosaminyltransferase, C2GnT3

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**SUBMISSION UNDER 37 C.F.R. § 1.501**

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

On behalf of the patentee, Glycozym Aps, please enter the following citation into the prosecution history of the above-identified patent. A copy of the cited reference is attached.

1. U.S. Patent No. 6,593,119

U.S. Patent No. 6,593,119 ("the '119 patent") was cited by the Examiner as a 35 U.S.C. §102(e) reference during the prosecution of two child applications of the instant patent (U.S. Patent No. 6,794,169; "the instant '169 patent"). Specifically, the '119 patent was cited during the prosecution of related applications U.S.S.N. 10/388,307, now U.S. Patent No. 7,094,887, and U.S.S.N. 10/843,723, now U.S. Patent No. 7,078,206. In each case, the 35 U.S.C. §102(e) rejection in view of the '119 patent was overcome.

The '119 patent was not cited by the Examiner during the prosecution of the application (U.S.S.N. 10/084,406) that resulted in the instant '169 patent. Consequently, we were not aware of

the Korczak '119 patent during the prosecution of the application that resulted in the instant '169 patent. Accordingly, the '119 patent is herewith being submitted under 35 U.S.C. § 1.501.

The present claims are patentable over the cited reference at least for the following reasons. The '119 patent is not prior art under 35 U.S.C. §102(e) to the instant '169 patent. The instant '169 patent claims priority to U.S. provisional application serial no. 60/150,488, which was filed on August 24, 1999. The '119 patent claims priority to U.S. provisional application serial no. 60/185,702, which was filed Feb. 29, 2000. Accordingly, the '119 patent is at best entitled to a priority date (Feb. 29, 2000) that is AFTER the priority date of the instant '169 patent (Aug. 24, 1999).

35 U.S.C. §102(e)(2) states that "a person shall be entitled to a patent unless a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent..." As discussed above, the '119 patent's earliest possible priority date is February 29, 2000, which is AFTER, not before, the instant '169 patent's priority date. Thus, the '119 patent is not prior art to the instant '169 patent.

Timely and favorable consideration of this request is respectfully requested.

It is believed that no fee is required for this request; however, the Commissioner is authorized to charge any deficiency of up to \$300.00 to Deposit Account No. 04-0100. If the Examiner has any questions in regard to this request, the Examiner is requested to contact the undersigned attorney at the telephone number given below.

Dated: December 1, 2006

Respectfully submitted,

By 

Heather Morehouse Ettinger

Registration No.: 51,658

DARBY & DARBY P.C.

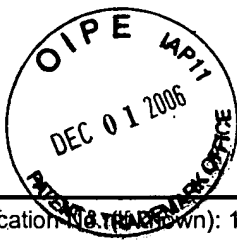
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Attorneys/Agents For Applicant



12-04-06

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Application No. (Unknown): 10/084,406

Attorney Docket No.: 04305/100G031-US2

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Submission Under 37 C.F.R. Section 1.501 (2 pages)  
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